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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,760	10/18/2005	Yutaka Shibui	01165.0934	9318
22852 7590 11/26/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER RAO, SHEELA S	
			ART UNIT 2125	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/522,760

Applicant(s)

SHIBUI, YUTAKA

Examiner

Sheela Rao

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This Office action is in response to papers filed on 4 September 2007.
2. Applicant's amendments and comments have been entered and considered.
3. Claims 1-5 and 9-11 are now pending. Claims 1-5 are amended, claims 6-8 are canceled, and claims 9-11 are newly added.

***Response to Amendment***

4. The rejection of claims 1 and 6 under 35 USC §112, second paragraph, is withdrawn in light of the amendments and cancellation, respectively, of the claims.
5. The rejection of claims 6-8 under 35 USC §101 is withdrawn in light of the cancellation of the rejected claims.
6. The rejection of claims 6-8 under 35 USC §102(b) as being anticipated by USPN 6,636,777 to Kokuba et al. is withdrawn for being moot since the claims have been canceled.

***Claim Rejections - 35 USC § 112***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim requires the "storage section" to store the clearance distance for the spacing of the tips; but states this "as inherent data of the tool rest". It is not clearly understood by the recitation within the claim language as to the meaning, relationship, or purpose of this "inherent data" with the clearance distance and how it is "inherent" to the tool rest. This deficiency occurs again in relation to the processing section for calculating.

In addition to above stated issues, at line 14 of claim 9, the phrase "secondary used" seems to cause grammatical inconsistencies within the claim language.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. Claims 9-11 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 6,636,777 B1 to Kokubo et al.

The prior art reference to Kokubo et al. (hereinafter, "Kokubo") teaches of a positioning device that is mounted on a machine tool used to position the tip end of a tool relative to the center axis of a bar without damaging the external periphery of the tool or bar. In doing so, Kokubo teaches the limitations of the instant invention.

With regard to claim 9, a storage section for storing data related to the tip and tool is taught as being stored in the storage part of the controlling section as stated at lines 6-10 of column 10. The processing section for calculating data to issue a position command is taught in column 8 at lines 25-28 as well as beginning at line 60 in column 9 as the corrective processing section that properly corrects the machining-position data for the tool. Lastly, the drive control section for controlling the motion along the axes is explained in column 8, lines 12-42, as the positioning device that includes a driving mechanism for positioning or moving a tool.

The control device being a numerical control device with a numerically controlled lathe, as per claims 10 and 11, respectively, is disclosed at column 5, line 66-67, as the automatically operated lathe, along with an explanation of the automatically operated lathe being a machine tool such as a NC, or numerically controlled, lathe at column 1, lines 22-26.

***Response to Arguments***

10. Applicant's arguments filed on 4 September 2007 have been fully considered but they are not persuasive.

Applicant states that the reference of prior art relied upon is known to the Applicant as it belongs to the same assignee. Examiner acknowledges the assignment of the instant application and prior art of reference, but interprets Applicant's statement as implying that the Art is not usable because it is commonly owned. This argument is non-persuasive because the rejection is under the statutes of 35 USC §102(b) not 35 USC §102(e). Therefore, the reference of prior art used to reject claims 6-8 (now claims 9-11) is maintained as aforementioned.

***Allowable Subject Matter***

11. Claims 1-5 are allowed.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

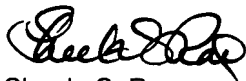
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Monday - Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. The fax number for the organization where this application or any proceeding papers is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. It should be noted that status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheela S. Rao  
November 20, 2007



LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100